REMARKS

Claims 1 and 3 are pending in the present application. Claims 2 and 4 are cancelled by this amendment, without prejudice and without any disclaimer of the subject matter therein. Claim 1 is amended to incorporate the elements of previously-pending claim 2. Claim 1 is also amended to recite that a "pharmaceutical composition" is formed. Claim 1 is further amended to recite that the composition comprises at least one conventional solid or liquid excipient or at least one conventional pharmaceutical auxiliary substance. Favorable consideration and allowance are respectfully requested for claims 1 and 3 in view of the foregoing amendments and following remarks.

The rejection of claims 1 – 4 under 35 U.S.C. § 112, first paragraph, as allegedly lacking adequate written description, is respectfully traversed.

To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail so that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. See, e.g., *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319, 66 USPQ2d 1429, 1438 (Fed. Cir. 2003). An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997).

The parent application, with substantially the same specification and with claims directed to, *inter alia*, methods of identifying compounds for inhibiting obesity, has issued as U.S. Patent No. 6,946,243. Accordingly, the PTO has determined the screening method is adequately described. The present claims add the step of incorporating a compound identified through the screening into a pharmaceutical form. Methods of incorporating such compounds into pharmaceutical formulations are provided at least on pages 13 and 15 of the specification.

The recent Office Action indicates the claims are directed to a composition that: (a) inhibits de nova lipogenesis, (b) does not possess anticonvulsant properties, and (c) inhibits carboanhydrase. The "does not possess anticonvulsant properties" element of the claims previously appeared in dependent claim 4, which is now cancelled. Accordingly the claims do not require a compound that does not possess anticonvulsant properties.

The recent Office Action also indicates that methods of performing the assays recited in the claims are disclosed in the specification and that the specification is enabling for the method of identifying compounds and then administering them to a patient.

In the specification, topiramate was provided as an example of a compound which might be identified as a carboanhydrase inhibitor using the inventive screening method as described beginning on page 9, second paragraph. Topiramate was selected because the treatment of obesity with topiramate is known (please see WO 98/00130 [Shank]). The use of topiramate as test compound demonstrates the suitability and the effectiveness of the presently claimed method. Because claim 4, which previously excluded compounds possessing anticonvulsant properties, is cancelled, the specification teaches a compound that meets all of the limitations of the present claims.

Accordingly, a person of skill in the art would reasonably conclude that the applicants had possession of the invention as claimed. Reconsideration and withdrawal of this rejection are respectfully requested.

The rejection of claims 1 – 3 under 35 U.S.C. § 103(a), over the applicants' alleged admissions in the specification and Shank (WO 98/00130), is respectfully traversed.

The cited art does not teach or suggest the selection criteria of the present claims. In particular, Shank is silent as to the de novo lipogenesis inhibiting activity of topiramate and similar compounds, and does not teach or suggest screening for carboanhydrase activity as a way to identify compounds suitable for de novo lipogenesis inhibition. Because the cited prior art does not teach

screening for carboanhydrase activity as a way to identify compounds suitable for de novo lipogenesis inhibition, the obviousness rejection cannot be properly maintained and reconsideration and withdrawal thereof are respectfully requested.

The rejection of claims 1 – 4 under 35 U.S.C. § 112, second paragraph, as allegedly indefinite is respectfully traversed.

As indicated above, claim 1 is amended to recite that a "pharmaceutical composition" is formed. Thus, one of skill in the art could determine the metes and bounds of the claim, and the claim is not, therefore, indefinite. Reconsideration and withdrawal of this rejection are therefore respectfully requested.

CONCLUSION

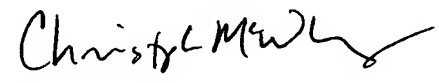
In view of the foregoing, the application is respectfully submitted to be in condition for allowance, and prompt favorable action thereon is earnestly solicited.

If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket No. 029300.49991D1).

Respectfully submitted,

October 20, 2006



J. D. Evans
Registration No. 26,269

Christopher T. McWhinney
Registration No. 42,875

CROWELL & MORING LLP
Intellectual Property Group
P.O. Box 14300
Washington, DC 20044-4300
Telephone No.: (202) 624-2500
Facsimile No.: (202) 628-8844
JDE:CTM:mdm (2871614)